

Remarks

This Amendment is submitted, together with an RCE, and contains amendments that follow up on the Response submitted under date of June 2, 2003. For the Examiner's convenience, the Applicants again address the issues raised in the Official Action of February 4, 2003 and additionally address the issues set forth in the June 17, 2003 Advisory Action. Specific comments concerning the Advisory Action are set forth below as an introduction to the base comments.

The Applicants note with appreciation the Examiner's helpful comments in the Advisory Action dated June 17, 2003. In that regard, the Applicants note for the record that many of the solicited independent claims, such as Claims 21 and 22, do not contain a preamble inasmuch as those claims are not presented in a traditional preamble, transitional phrase, body format. There is no transitional phrase, therefore, the "doll's clothing" language is not in the preamble. Thus, such language must be given patentable weight. In any event, it is well settled that language in a preamble must be given patentable weight when that language "breathes life and meaning" into the claim. That is the case here, wherein the essence of this invention is a seamless doll's garment formed from an injection molded thermoplastic elastomer. Although the language is relatively short and simple, it is a fact that the essence of this invention is a seamless doll's garment and that such language "breathes life and meaning" into the claim. As a consequence, all of the language in those claims must be given patentable weight.

Others of the claims, such as Claim 38, were already in the traditional preamble, transitional phrase and body format. Moreover, the doll's seamless garment language in that claim fell after the transitional phrase (which was "comprising") and was located in the body. As a consequence, such language was, in fact, a limitation in that claim and also must be given patentable weight.

Accordingly, the Advisory Action was issued in error in that respect.

With respect to the “wrapping” aspect of the Examiner’s helpful comments, the Applicants respectfully submit that 1) there are utterly no teachings or suggestions to wrap the laminate around a doll and 2) such wrapping would cause seams or overlaps to occur by the act of wrapping the laminate over the doll. The Applicants therefore respectfully submit that the “wrapping” theory with respect to the laminate of Yasuda has no bearing on the invention. The claims are accordingly in condition for allowance.

In any event, the Applicants have amended the independent claims to further emphasize such inapplicability. For example, Claims 21 has been amended to recite a garment comprising a seamless injection molded thermoplastic elastomer doll’s garment having a molded shape to fit over at least a portion of a doll and a wall thickness from 1 to 3 mm. Similarly, Claim 22 has been amended to recite a garment comprising a seamless injection molded thermoplastic elastomer doll’s garment having a molded shape to fit over at least a portion of a doll and an average modulus of elasticity of less than 1 MN/m². Claim 38 has been amended to recite a play set comprising in cooperative combination a doll donned and fitted with a seamless injection molded garment which is molded to be removed, dressed and refitted again to the doll in a lifelike manner.

Both of Claims 21 and 22 are now in the traditional preamble, transitional phrase body format. Both the seamless aspect of the invention and the doll aspect of the invention is now in the body. Those aspects must be given patentable weight. With respect to the wrapping aspect mentioned above with respect to Yasuda, both claims now recite that the garment has a molded shape to fit over at least a portion of a doll. The imagined wrapped laminate which allegedly forms a doll’s garment is in the most crudest sense only able to be formed into an approximate shape of at

least a portion of a doll as a consequence of the act of wrapping the laminate around the doll. Such an approximate shape, if it can even be called that, is only able to be formed so long as the laminate is wrapped around the doll. The moment that the laminate is unwrapped from the doll, it loses that crude approximate shape because it is nothing more than a laminate sheet. The wrapped laminate is inherently incapable of maintaining its shape to fit over at least a portion of the doll.

In sharp contrast, Claims 21 and 22 recite that the garment has a molded shape to fit over at least a portion of a doll. This means that the garment is molded into a particular shape and retains that shape irrespective of whether the garment is fitted over the doll or removed from the doll and lying unused. As examples, the Applicants invite the Examiner's attention to the various Figs. 1a – 1f, which show seamless injection molded thermoplastic elastomer doll's garments which have a molded shape to fit over at least a portion of a doll. In all of the Fig. 1 variations, the garments are removed from the doll. However, they fully retain their shape and form as a garment. This is simply not true of the wrapped laminate theory espoused in the Advisory Action.

The remaining independent claims were already in traditional preamble, transitional phrase and body format and the seamless doll aspect of the invention was already in the body. Accordingly, the preamble argument was already moot. The wrapping aspect, as mentioned above, applies equally to those claims.

As a result of the comments set forth above and the amendments made herein, the Applicants respectfully submit that Yasuda fails to disclose, teach or suggest the invention as recited in the claims. Moreover, there is utterly no motivation to one of ordinary skill in the art to make modifications to Yasuda that would lead one of ordinary skill in the art to the invention as recited in the solicited claims.

Turning now to the issues raised in the February 24, 2003 Official Action, the Applicants acknowledge the rejection of Claims 20-23, 25-32, and 47-51 as being obvious over Yasuda. The Applicants respectfully submit that Yasuda fails to disclose, teach or suggest the invention as recited in those claims and further fails to provide motivation to one of ordinary skill in the art to make modifications to Yasuda that would lead one of ordinary skill in the art to the invention as recited in those claims as amended above.

The Applicants note with appreciation the examiner's helpful and detailed comments concerning the Yasuda disclosure and where certain aspects of that disclosure may be found. The Applicants will accordingly address each of those helpful comments and the respective locations in order to the extent possible.

The Official Action takes the position that Yasuda discloses a seamless doll's garment with support being found for the "seamless" portion at Fig. 1 and the doll's garment portion at column 19, second line from the bottom. The Applicants respectfully submit that Fig. 1 of Yasuda discloses nothing more than a three-layered laminate. The three-layered laminate is formed from a resin layer 2A laminated on a resin layer 2B by an adhesive layer 3. The three-layered laminate appears to be seamless. However, Fig. 1 does not show, teach or suggest in any way a doll's garment. The structure shown in Fig. 1 is nothing more than a three-layer laminate. If one of ordinary skill in the art were to look at Fig. 1, it would be totally non-enabling with respect to the suggestion that it has anything to do with dolls, garments and/or doll's garments. Moreover, the "wrapping" theory is merely imaginary. There are no teachings or suggestions in Yasuda to do so.

The paragraph spanning columns 19 and 20 of Yasuda discloses the following:

The laminate of the invention can be cut into desired shape and size for broad application as a constituent element of toys or dolls, such as stuffed toys, clothes of

dolls, accessories of dolls (e.g., ribbons and other fancy goods), pop-up picture books, and the like, to add a visual charm of changing the form, an outstanding appearance, and a design effect.

The Applicants agree that Yasuda states “clothes of dolls.” However, there is no disclosure, no teaching and no suggestion that the laminate itself is a “clothes of dolls” or should be wrapped to form clothes of dolls. Instead, the entire sentence, which provides the proper context, states that the laminate can be cut into a shape and size so that the laminate portion can be used as a constituent element of clothes of dolls--not as clothes by itself. By definition, the fact that the laminate is only a constituent element means that the laminate itself, taken alone, does not constitute a doll’s garment. At best, it can be a portion of or an attachment to a doll’s garment.

As a consequence, neither Fig. 1 nor the paragraph spanning columns 19 and 20 disclose, teach or suggest a seamless doll’s garment. In fact, by virtue of the fact that Yasuda teaches that the laminate is only a constituent portion of a doll or clothes of dolls, this inherently means that any doll’s garment utilizing the laminate as a constituent element would not be seamless and would not be wrapped around a doll. There would need to be some means to attach the constituent element, i.e., the laminate, which inherently would produce some type of seam.

Accordingly, the Applicants respectfully submit that Yasuda not only does not teach a seamless doll’s garment, but that it teaches what would inherently at best be a piece of clothing for a doll’s garment having a seam by virtue of application of the laminate of Yasuda as a constituent element of such clothes. The Applicants specifically claim “seamless” and Yasuda specifically discloses structure resulting in seams. The reason for this is quite clear. Yasuda does not intend for the laminate to be clothes of dolls, wrapped or otherwise, but only intends for the laminate to be a constituent part of the clothing so that it can be utilized as a decorative element. This is briefly

explained at the top of column 20 in line 2. It is simply for appearance, not functional use. On this basis alone, the Applicants respectfully submit that the claims are patentably distinct.

The solicited claims call for a seamless doll's garment formed from an injection moldable thermoplastic elastomer in a molded shape to fit over at least a portion of a doll. The Applicants note with appreciation the examiner's helpful comments concerning injection molding at column 5 line 42. That full paragraph states the following:

The resin molded articles which can be used as a resin layer of the laminate include small pieces other than films and extruded or injection molded articles of any shape and size.

The above paragraph refers to injection molded articles of any shape and size. However, it states that the resin molded articles are used as a resin layer of the laminate. In other words, Yasuda teaches injection molding articles having a single layer and then using those injection molded articles as constituents of a laminate. Yasuda does not teach or suggest that his invention (i.e., the laminate) is injection molded. It clearly is not as a result of the teachings of the paragraph in column 5 beginning at line 40. As a consequence, there are utterly no teachings or suggestions to those of ordinary skill in the art to injection mold a seamless doll's garment based on Yasuda. His references to injection molding are merely formation of injection molded articles that can be used as part of a layer. This is not the same as a teachings or suggestions to injection mold a seamless doll's garment.

Moreover, the claims recite that the garment has a molded shape to fit over at least a portion of a doll. This simply does not exist in Yasuda and there are no teachings or suggestions that would lead one of ordinary skill in the art to form such a garment. The laminate of Yasuda does not have a molded shape to fit over at least a portion of a doll. There are several reasons for this. First, the laminate of Yasuda is not molded as set forth above. It is merely a laminate of a multiplicity of

layers. This inherently is not molded. There is also no shape to fit over at least a portion of a doll. It is merely a sheet and does not have a shape that is substantially in conformance with the corresponding shape of a doll. In other words, if the laminate of Yasuda was not wrapped around a doll, it would not be a garment and it would have no shape wherein the shape fits over at least a portion of a doll. In sharp contrast, in the invention, the garment still retains the shape of the doll irrespective of whether it is fitted over the doll or not.

The Applicants agree that Yasuda discloses a thermoplastic elastomer. In fact, Yasuda discloses a large number of resins that may be utilized to form films suitable for use to form the laminate. There is, however, a radical difference between films whether thermoplastic or otherwise or elastomer or otherwise and an injection molded seamless doll's garment. A doll's garment is not a film which is what Yasuda teaches. Yasuda specifically teaches a laminate of multiple films. The Applicants do not injection mold films made of thermoplastic elastomer. Instead, the Applicants injection mold thermoplastic elastomer directly into a seamless doll's garment. This is simply not disclosed, taught or suggested by Yasuda.

The Applicants note with appreciation the examiner's helpful comments concerning the garment including a detail/ribbon as set forth on column 19, last line. The Applicants agree that column 19, last line refers to ribbons and other fancy goods that are utilized as accessories for dolls. However, there is utterly no teaching, disclosure or suggestion with respect to the fact that the garment includes integrally molded details of such items. Instead, the ribbons and other fancy goods are merely referred to as constituent elements and are not integrally molded details in the garment itself. Careful scrutiny of the entire Yasuda disclosure reveals that there is not one word of disclosure on this point. Withdrawal of the rejection is accordingly respectfully requested.

The Applicants note with appreciation the examiner's frank acknowledgement that Yasuda does not disclose that the garment has a wall thickness of 1 to 3 mm as recited in Claims 21 and 47, that it does not disclose the thermoplastic elastomer having an average modulus of elasticity of less than 1 MN/m² as recited in Claims 22, 30-32, 47 and 50-51, does not disclose a finish selected from the group consisting of paint, varnish and glitter as recited in claim 26 and does not disclose that the garment is less than 8 cm in height as recited in claim 28. The Applicants agree in all respects with the examiner's acknowledgement thereof.

The Official Action then takes the position that it would be obvious to provide a garment of Yasuda with the claimed thickness for the purpose of making the devices easier to play with. The Applicants respectfully submit that Yasuda teaches just the opposite. The general disclosure of Yasuda does not provide any guidance concerning the thickness of the laminate or the thickness of the resin layers forming the laminate. However, Yasuda does provide a multiplicity of examples which specifically set forth the thickness of the individual layers comprising the laminate. Those thicknesses are set forth in the chart below for the examiner's convenience.

Example	Overall thickness (μm , or mm^{-3})
1	100
2	115
3	150
4	70
6	65
7	85
8	85
9	125
10	150
11	100
12	92
13	92
14	75
15	75

16	92
17	100
18	100
19	120
23	100
24	100

It is clear from these examples that the laminate thickness of Yasuda ranges between 65 μm all the way up to 150 μm . In sharp contrast, Claims 21 and 47 recite a wall thickness of 1 to 3 mm. The equivalent thickness is 1,000 μm to 3,000 μm .

This is a radical difference in thicknesses and there are no teachings, disclosure or suggestions in Yasuda to increase the thickness at all, much less increasing the thickness to the thickness recited in the solicited claims. At a minimum, the claimed thickness is more than 6 1/2 times larger than the thickness of the thickest Yasuda laminate. At the other end of the spectrum, the claimed range is over 46 times larger than that taught by Yasuda. The Applicants accordingly ask the question: "How could increasing the thickness by at least 6½ times make the garments easier to repeatedly fit over and remove from a doll?" The answer is simple: one of ordinary skill in the art would not tend to increase the thickness of a laminate to make it easier to use on a doll assuming that the laminate was in fact a doll's garment. Logic suggests that removing the garment and reapplying it to a doll with legs and arms would only be more difficult if the thickness were increased. Logic suggests that there would be no gain in the ease of playing with the doll and/or the doll's garment by increasing the thickness. It is well known that increasing thickness tends to make an item stiffer and less pliable relative to a thinner item.

As a consequence, the Applicants respectfully submit that Yasuda actually leads one of ordinary skill in the art away from the claimed wall thickness aspect of the invention. If one of

ordinary skill in the art were to view the thickness teachings of Yasuda, one of ordinary skill in the art would tend to reduce the thickness to the level of Yasuda, not to increase the thickness to the claimed range, which is radically different from the taught thickness of the laminate of Yasuda.

With respect to the claimed modulus of elasticity of less than 1 MN/m², the Applicants respectfully submit that Yasuda has utterly no appreciation for this claimed aspect of the invention. Careful scrutiny of the entire disclosure reveals that there is not one word concerning modulus of elasticity. Moreover, inasmuch as the laminate of Yasuda is merely a constituent element of dolls or clothes of dolls, elasticity, in the context in which it is utilized herein, is essentially unimportant. Moreover, to the extent that there is an issue of deformability in Yasuda, Yasuda provides very specific teachings as to how to achieve such deformability. This is, of course, achieved in Yasuda by utilization of individual layers that have different coefficients of thermal expansion to form laminates. Differing temperatures cause expansion/contraction of the various resin layers at different rates, thereby willfully and deliberately causing deformation. This is a serious departure from the claimed invention which utilizes a specifically claimed modulus of elasticity to achieve the desired amount of elasticity in those claims.

The Applicants respectfully submit that one of ordinary skill in the art would not look to a particular modulus of elasticity to achieve overall elasticity in deformability as a consequence of looking to Yasuda. Instead, one of ordinary skill in the art would at best take a sharply different path, utilize multiple layers of resins having different coefficients of thermal expansion to form a laminate that is deformable based on temperature differences. The Applicants have no concern at all with respect to such an approach and the claimed modulus of elasticity is nowhere disclosed,

taught or suggested by Yasuda. Again, Yasuda goes in a completely different direction leading one of ordinary skill in the art away from that claimed aspect.

With respect to the claimed height, careful scrutiny of Yasuda once again reveals that it is totally deficient with respect to any disclosure on this point. Moreover, there is nothing in Yasuda that would motivate one of ordinary skill in the art to make any changes in height. In fact, height is not mentioned at all and there is utterly no importance attached to this aspect of the claimed invention. Again, the Applicants ask the question: "Where is the motivation to one of ordinary skill in the art to employ a specific doll height based on the disclosure of Yasuda?"

Turning to Claims 33-46 and the hypothetical combination of Gross with Yasuda, the Applicants respectfully submit that one of ordinary skill in the art would have no motivation to make the hypothetical combination in the first place and, in the second place, even if one of ordinary skill in the art were to make the hypothetical combination, the resulting product would still fail to teach or suggest the invention as recited in those claims.

The fundamental concept of Gross differs completely from that of a fundamental objective of the invention, which is to provide seamless dolls' garments that are easily removable from a corresponding doll. Gross has an opposite objective, wherein a rigid core is covered with an elastic skin that is not at all removable, but is partially adhered to the rigid core to facilitate selected areas where the skin may expand relative to the core to simulate changes in muscle tone or weight gain. Certainly, Gross has nothing to do with the invention.

Gross also has nothing to do with Yasuda, which relates to a laminate that can have any number of fabrics of various types bonded to it as decorative elements. As a consequence, one of ordinary skill in the art would have no motivation at all to hypothetically combine Gross with

Yasuda. Moreover, even if one of ordinary skill in the art were to go against the teachings of those individual publications, the results of such a hypothetical combination would still fail to teach or suggest the invention as recited in the solicited claims. Withdrawal of this rejection is accordingly respectfully requested.

In light of the above sharp differences of the invention as recited in the solicited claims from Yasuda and Gross, we respectfully submit that all of the solicited claims are clearly patentable over the references, whether taken individually or collectively.

The Applicants fully acknowledge that the broadest of the claims are short and relatively simple in appearance. However, it is a fundamental principle that brevity and relative simplicity are not the test of patentability. In such cases, it is often easy to employ forbidden hindsight to reject claims, despite the total lack of disclosure, teachings or suggestions in the prior art that would lead one of ordinary skill in the art to an invention as claimed. This appears to be true in this case inasmuch as Yasuda is simply completely devoid of disclosure, teachings or suggestions relative to a number of the specifically claimed aspects of the invention.

Moreover, in this case, Yasuda actually provides several instances where the disclosure teaches away from the claimed invention. For example, selected ones of the solicited claims recite a wall thickness from 1 to 3 mm, which is 1,000 to 3,000 μm . In sharp contrast, Yasuda teaches laminate thicknesses at least 6 1/2 times smaller than the claimed invention and provides no teachings or suggestions to those of ordinary skill in the art to increase the thickness. As previously discussed, increasing the thickness would likely decrease the ability to make the devices easier to play with, which is a favorable aspect of this invention. This is a classic case of the prior art teaching away from the claimed invention.

The Court of Appeals for the Federal Circuit has decisively confirmed this point in its recent decision *In re Fritch*, 23 U.S.P.Q. 2d, 1780 (Fed. Cir. 1992). The CAFC has clearly prohibited hindsight:

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." 23 U.S.P.Q. 2d at 1783-1784.

The foregoing discussion is binding with respect to this application. It is impermissible to pick and choose portions of a disclosure and use hindsight reconstruction to reject the claims herein.

It is also a fundamental aspect of the law concerning obviousness that there not only be teachings and suggestions that would motivate one of ordinary skill in the art to make modifications, but that there be a reasonable expectation of success associated with such a disclosure.

In this case, again referring to the wall thickness aspect of the invention, Yasuda teaches relatively small laminate thicknesses relative to the claimed wall thickness of the invention, which is at least 6 1/2 times larger than the thickness of the laminate. One of ordinary skill in the art would have little expectation of success, much less a reasonable expectation of success that increasing the thickness of the doll's garment would make the garment easier to play with. One of ordinary skill in the art would likely think just the opposite, namely that increasing the wall thickness would decrease the ease with which the garment could be used.

As a consequence of the law clearly applicable to the solicited claims, when taken in view of Yasuda, there can be no doubt that the solicited claims are patentable over Yasuda. Yasuda simply fails to provide disclosure, teachings or suggestions that upon which a 35 U.S.C. §103

obviousness rejection can be based. The Applicants accordingly respectfully request withdrawal of the rejection.

In light of the foregoing we respectfully submit that the entire application is now in condition for allowance which is respectfully requested, respectfully submitted.

Respectfully submitted,


T. Daniel Christenbury
Reg. No. 31,750

TDC:lh
(215) 656-3381